

REMARKS

Claims 1-8, 10-12, 14-26, 28-30, 32-44, 46-48, and 50-58 are currently pending.

Claims 9, 13, 27, 31, 45, and 49 were previously canceled.

In the Office Action mailed April 28, 2008, the Examiner rejected claims 1-8, 10-12, 14-26, 28-30, 32-44, 46-48, and 50-58 under 35 U.S.C. § 112, first paragraph.

Based on the following remarks, Applicants respectfully traverse the rejection of claims 1-8, 10-12, 14-26, 28-30, 32-44, 46-48, and 50-58 under 35 U.S.C. § 112, ¶ 2, and request the timely allowance of the pending claims.

I. Information Disclosure Statement

As an initial matter, Applicants respectfully note that initialed copies of the Form PTO/SB/08 and Information Disclosure Statement filed August 30, 2007, have not been received by Applicants. For the Examiner's convenience, Applicants have attached herewith copies of the August 30, 2007 Information Disclosure Statement and Form PTO/SB/08, and a copy of the postcard stamped by the U.S. Patent and Trademark Office indicating receipt of the Information Disclosure Statement and PTO/SB/08 on August 30, 2007.

Applicants respectfully request that the Examiner consider the documents listed on the enclosed Form PTO/SB/08. Applicants also request that an initialed copy of the PTO/SB/08 be returned with the next communication from the Office.

II. Rejection under 35 U.S.C. § 112, First Paragraph

The Examiner rejected claims 1-8, 10-12, 14-26, 28-30, 32-44, 46-48, and 50-58 under 35 U.S.C. § 112, first paragraph, as allegedly "containing subject matter which was not described in the specification in such a way as to reasonably convey to one

skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.” Office Action, p. 2. Specifically, the Examiner states that “modifying one or more financial terms of the offer based on the collected information and the response and presenting the modified offer to the at least one of the set of users’ [] does not appear to be in the originally filed specification.” Id. at p. 3.

Applicants respectfully disagree with the Examiner’s characterization of the claims as lacking written description in the specification. M.P.E.P. § 608.01(o) states, “[t]he meaning of every term used in any of the claims should be apparent from the descriptive portion of the specification with clear disclosure as to its import.” However, “[t]here is no requirement that the words in the claim must match those used in the specification disclosure.” M.P.E.P. § 2173.05(d).

Here, the as-filed specification discloses several embodiments that describe “modifying one or more financial terms of the offer based on the collected information and the response; and presenting the modified offer to the at least one of the set of users,” as recited in independent claim 1, and similarly recited in independent claims 12, 16, 19, 30, 34, 37, 48, and 52. For example, and without limitation, Applicants respectfully direct the Examiner’s attention to Applicants’ specification at page 11, lines 12-18, page 12, lines 11-20, page 13, lines 3-20, page 14, lines 3-22, and Figures 8 and 9.

Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of independent claims 1, 12, 16, 19, 30, 34, 37, 48, and 52 under 35 U.S.C. § 112, ¶ 1. Claims 2-8, 10-11, and 54 depend from independent claim 1. Claims 14 and 15 depend from independent claim 12. Claims 17, 18, and 55 depend from

independent claim 16. Claims 20-26, 28-29, and 56 depend from independent claim 19. Claims 32 and 33 depend from independent claim 30. Claims 35, 36, and 57 depend from independent claim 34. Claims 38-44, 46-47, and 58 depend from independent claim 37. Claims 50 and 51 depend from independent claim 48. Claim 53 depends from independent claim 52. Accordingly, because of their corresponding dependence from independent claims 1, 12, 16, 19, 30, 34, 37, 48, and 52, Applicants respectfully request that the Examiner also withdraw the rejection of dependent claim 2-8, 10-11, 14-15, 17-18, 20-26, 28-29, 32-33, 35-36, 38-44, 46-47, 50-51, and 53-58 under 35 U.S.C. § 112, ¶ 1.

Applicants respectfully note that the Examiner only set forth rejections of claims 1-8, 10-12, 14-26, 28-30, 32-44, 46-48, and 50-58 under 35 U.S.C. § 112, ¶ 1. Given the requirements set forth by the M.P.E.P., Applicants assume that the pending claims are patentable over the prior art in view of 35 U.S.C. §§ 102 and 103.¹ Therefore, Applicants respectfully request the timely allowance of pending claims 1-8, 10-12, 14-26, 28-30, 32-44, 46-48, and 50-58.

¹ “Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the initial review of the application, even if one or more claims are to be found deficient with respect to some statutory requirement.” M.P.E.P. § 2106(II) (emphasis added). “Once USPTO personnel have concluded the [] analyses of the claimed invention under all the statutory provisions, including 35 U.S.C. 101, 112, 102, and 103, they should review all the proposed rejections and their basis to confirm that they are able to set forth a *prima facie* case of unpatentability.” M.P.E.P. § 2106(VII) (emphasis added). “Only then should any rejection be imposed in an Office action.” *Id.* (emphasis added).

III. Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

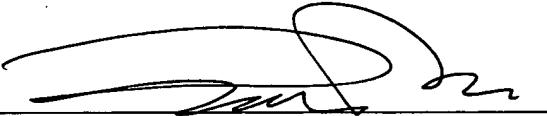
Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: September 26, 2008

By:


Joseph E. Palys
Reg. No. 46,508

Attachments: Copy of Information Disclosure Statement filed August 30, 2007;
Copy of Form PTO/SB/08 filed August 30, 2007; and
Copy of the stamped postcard dated August 30, 2007.